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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/147,237 04/20/99 YAGI

E TOS-123-USA

HM22/1013

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EXAMINER

PRATS, F

ART UNIT

PAPER NUMBER

1651

17

DATE MAILED:

10/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/147,237

Applicant(s)  
Eiichiro Yagi et al

Examiner  
Francisco C. Prats

Group Art Unit  
1651



☒ Responsive to communication(s) filed on Aug 4, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) 5-14 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-4 and 15-17 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**DETAILED ACTION**

1. The request filed on August 4, 2000, for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/147,237 is acceptable and a CPA has been established. An action on the CPA follows.
2. The previously unentered after-final amendment filed June 12, 2000, has been entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.
3. Claim 18 has been cancelled.
4. Claims 1-17 are pending.

***Election/Restriction***

5. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

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In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-4, and 15-17 drawn to glutathione-containing therapeutic compositions.

Group II, claim(s) 5 and 6, drawn to Scutellaria root extract-containing therapeutic compositions.

Group III, claim(s) 7 and 8, drawn to linden extract-containing therapeutic compositions.

Group IV, claim(s) 9 and 10, drawn to clove extract-containing compositions.

Group V, claim(s) 11 and 12, drawn to Geranium herb extract-containing compositions.

Group VI, claim(s) 13 and 14, drawn to rosemary extract-containing compositions.

6. The inventions listed as Groups I through VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Each of the groups recite a different product having different ingredients. Thus, a reference anticipating one of the groups would not necessarily anticipate or even render obvious

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any of the other groups. In such a situation a general inventive concept clearly is not present.

7. Applicant's election of the group I invention, claims 1-4, in Paper No. 6, filed June 25, 1999, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

8. Claims 5-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. As discussed immediately above, election was made without traverse in Paper No. 6, filed June 25, 1999.

9. Claims 1-4 and 15-17 are examined on the merits.

***Claim Rejections - 35 USC § 102***

10. Claims 1-4 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by N'Guyen et al (U.S. Pat. 5,023,235).

N'Guyen '235 discloses the preparation of a "Solar cream" which comprises 0.05 weight percent glutathione. See col. 7, lines 12-35, especially line 22. Inherent in the disclosure of a

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product as a "solar cream" is the disclosure of applying said cream to the skin before or during exposure to ultraviolet light. Thus, the reference discloses applying a composition having the claimed active ingredient in the claimed amount to the claimed part of the body of the claimed recipient. The reference therefore discloses all of the process steps claimed.

It is noted that the claims now recite the administered composition as one "consisting essentially of" glutathione. It is also noted that the composition disclosed in the '235 patent contains numerous ingredients in addition to the glutathione and cosmetic carrier recited in applicant's claims. However, MPEP § 2111.03 clearly states that "[t]he transitional phrase 'consisting essentially of' limits the scope of a claim to the specified materials or steps 'and those that do not materially affect the basic and novel characteristic(s)' of the claimed invention." (Citations omitted, emphasis in original.) On the current record there is no evidence that any of the additional ingredients present in the prior art composition would affect the basic and novel properties of the prior art composition such that the prior art composition is truly different than the claimed composition. Thus, applicant's claims must be construed as encompassing the additional ingredients in the prior art

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composition, despite the "consisting essentially of" language. A holding of anticipation is therefore required.

Lastly, note specifically that MPEP 2111.03 further provides that "[w]hen an applicant contends that additional steps or materials in the prior art are excluded by the recitation of 'consisting essentially of,' applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention." (Citations omitted.)

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F.C. Prats whose telephone number is (703) 308-3665.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael G. Wityshyn, can be reached on (703) 308-4743.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Communications applicant wishes to submit by FAX should be submitted to FAX # (703) 305-4242 or (703) 305-3014.



FRANCISCO C. PRATS  
PRIMARY EXAMINER  
ART UNIT 1651

F.C. Prats  
October 11, 2000